

### **REMARKS**

Reconsideration of this application and entry of the amended claims as presented herein are respectfully requested. Applicants submit that entry of these claims places them in condition for allowance or, if allowance is refused, in better condition for appeal.

Claims 6-12, 14-17, and 23-28 are pending. The Office Action rejects claims 6-10, 14-17, and 23-28. The Office Action also objects to claims 11 and 12 as dependent upon a rejected claim. Following entry of the proposed amendments, claims 6-12, 14-17, and 23-28 are pending, with claims 1-5, 13, 18-22, and 29-35 having been cancelled.

Claims 6 and 23 are amended by this response. The amendments to claims 6 and 23 are supported at paragraph [0044] of the specification as filed as well as throughout the original specification and claims.

Entry of all amendments and allowance of all claims is respectfully requested.

### **OBJECTIONS AND REJECTIONS**

#### **35 U.S.C. § 102(e)**

The Office Action rejects claims 6-10, 14-17, and 23-26 under 35 U.S.C. § 102(e) as allegedly anticipated by published United States Patent Application No. 2004/0091324 ("the '324 application"), to Schilling, *et al.* The claims are not anticipated by the '324 application.

Claims 6-10, 14-17, and 23-26 are not anticipated by the '324 application, because the information cited in the Office Action as allegedly anticipating those claims is not entitled to a § 102(e) priority date early enough to overcome the February 19, 2003 priority date of the instant

application. The '324 application claims priority to two United States provisional patent applications. Only one of those provisional patent applications, No. 60/393,170, filed on July 2, 2002 ("the '170 provisional"), antedates the priority date of the instant application. Therefore, the '324 application qualifies as a 102(e) reference only for that information that is supported by the '170 provisional. *See* M.P.E.P. § 2136.03(III).

The '170 provisional does not include the lignin language cited in the Office Action and appearing at page 3, paragraph [0028] of the '324 application. Moreover, the '170 provisional only discusses lignin sulfonate in the background of the invention, not as a component of any inventive composition. For a reference to anticipate a claim, the reference must include, either expressly or inherently, all of the limitations of the claim. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d1913, 1920 (Fed. Cir. 1989), *quoted in* M.P.E.P. § 2131. Therefore, the '324 application may not be used in any rejection involving use of lignin in combination with a sugar solution as claimed in the application.

The '324 application is also not a competent reference for the proposition that dust may be controlled by "a composition comprising a hemicellulose solution comprising 10-20% free sugars composed primarily of monosaccharides," as cited in the Office Action. Instead, the '170 provisional cites only "10-20% free sugars." (page 2, paragraph [0017]). There is no evidence that the "10-20% free sugars" are primarily monosaccharides. Indeed, there is no indication that they contain monosaccharides at all.

The Office Action rejects claims 6-8, 23, and 24 under 35 U.S.C. § 102(e) as allegedly anticipated by United States Patent No. 6,790,245, to Wolff, *et al.* ("the '245 patent."). The '245

patent does not teach all of the limitations of claims 6-8, 23, and 24. The only sugar that is mentioned in the '245 patent is sucrose, which is a disaccharide, not a monosaccharide as claimed in the instant application. Therefore, the rejection based on the '245 patent should be withdrawn and the claims allowed.

35 U.S.C. § 102(b)

The Office Action rejects claims 6, 7, 23, and 24 under 35 U.S.C. § 102(b) as allegedly anticipated by United States Patent No. 1,910,975, to Wallace ("the '975 patent"). As do the other cited publications, the '975 patent reports only use of sucrose, a disaccharide. The '975 patent does not include all of the limitations of claims 6, 7, 23, and 24 as amended; therefore, the '975 patent does not anticipate those claims under 35 U.S.C. § 102(b). The rejection under 35 U.S.C. § 102(b) has been traversed. The rejection should be withdrawn and the claims allowed.

35 U.S.C. § 103(a)

The Office Action rejects claims 27 and 28 under 35 U.S.C. § 103(a) as allegedly unpatentable over the '324 application, the '245 patent, or the '975 patent, in view of United States Patent No. 5,714,387, to Fowee, *et al.* ("the '387 patent"). As set forth above, neither the '324 application, the '245 patent, nor the '975 patent includes all of the limitations of any of the claims from which claims 27 and 28 depend.

The '387 patent fails to remedy the shortcomings of the previously cited publications, because it does not supply a monosaccharide limitation to the claims. The dust control agents reported by the '387 patent are either surfactants or polymers. See, for example, the tables beginning at column 2, line 60 and column 3, line 5 of the '387 patent, as well as column 1, lines

21-22. ("Chemical dust control agents such as surfactants and/or polymers are used to treat a variety of solid materials....")

When combined with the '387 patent, the cited publications still fail to teach or suggest all of the limitations of claims 27 and 28. Claims 27 and 28 are therefore not unpatentable over the '324 application, the '245 patent, or the '975 patent in light of the '387 patent. The rejections should be withdrawn and claims 27 and 28 should be allowed.

### **CONCLUSION**

Applicants submit that all of the stated grounds of objection and rejection have been properly traversed or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and objections and that they be withdrawn. Applicants further request that the claims be amended as set forth herein, and that all amended claims be allowed. Applicants believe that a full and complete reply has been made to the outstanding Office Action and as such the present application is in condition for allowance.

If the Examiner believes for any reason that personal communication will expedite prosecution of this application, the Examiner is asked to please to contact the undersigned at the telephone number provided. Prompt and favorable consideration of this Response is respectfully requested.

### AUTHORIZATION

It is believed that no extension of time is necessary to make this Response timely. It is also believed that all excess claims fees have been properly calculated and paid. In the event that an extension of time and/or payment of excess claims fees is necessary, kindly deduct the cost for same from Deposit Account No. 02-4553 in the name of Buchanan Ingersoll PC.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Duane A. Stewart III", with a stylized flourish at the end.

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